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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,494	07/26/2001	Samuel L. Forusz	70452P002	9795

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EXAMINER

PRATT, HELEN F

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 04/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AC

Office Action Summary	Application No. 09/917,494	Applicant(s) FORUSZ ET AL.	
	Examiner Helen F. Pratt	Art Unit 1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2004.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-12 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3, 6-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 6-12 of U.S. Patent No. 6,436,446. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims show the instant ingredients, and it would have been obvious to one of ordinary skill in the art to make a product with a particular viscosity with known ingredients. Further nothing is seen that the claimed viscosity is not disclosed by the above reference as the ingredients are the same. This rejection is maintained. The claims have been amended to require at least 10 % of the daily amount of dietary fiber. However, it is not known what the daily amount of dietary fiber is. The reference discloses at least 10% of fiber in the composition (col. 5, lines 15-20, and col. 6, lines 10-15). The two amounts of fiber make at least 10%.

Claim Rejections - 35 USC § 112

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The independent claims are indefinite in the use of the phrase "a dietary acceptable amount of a first soluble fiber of inulin". It is not known what is considered a "dietary acceptable amount of inulin. The independent claims are also indefinite in the use of the phrase "at least 10% of the daily amount of dietary fiber". It is not known what applicants consider to be the daily amount of fiber.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forusz et al. (6,436,446).

The claims are rejected for the reasons of record and for these further reasons. The independent claims have been amended to require at least 10% of the daily amount of fiber. The reference discloses at least 10% of fiber in the composition (col. 5, lines 15-20, and col. 6, lines 10-15). The two amounts of fiber make at least 10%. Certainly, the reference believes this to be an adequate amount of fiber. It would have

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been within the skill of the ordinary worker to vary the amounts of fiber, as its function is well known. Also, the reference does disclose the use of inulin and it is seen as listed first in the composition (col. 5, lines 54-70). No patentable distinction is seen in calling it a first fiber. Therefore, it would have been obvious to use inulin as disclosed by the reference.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6-12 are rejected under 35 U.S.C. 103(e) as being unpatentable over Forusz et al. '446. The claims are rejected for the reasons of record cited in the last office action. Nothing has been shown by a way of a showing that the compositions are different particularly as to viscosity. The further limitations have been discussed above in the double patenting rejection and are obvious for those reasons.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 6-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stillman in view of Topping ('326) in view of Green (EP 0756828).

The claims are rejected for the reasons of record cited in the last office action and for these further reasons. The claims are rejected for the reasons of record and for these further reasons. The independent claims have been amended to require at least 10% of the daily amount of fiber. The reference discloses at least 10% of fiber in the composition (col. 5, lines 15-20, and col. 6, lines 10-15). The two amounts of fiber make at least 10%. Certainly, the reference believes this to be an adequate amount of fiber. The specification discloses from 0.26 to 6% (w/v) of inulin and 0.0026 to 33 of maltodextrin, which is within the range disclosed by Stillman, in particularly (page 4, para. 0012 and 0013). As it is not known what amount of fiber is required, it would have been within the skill of the ordinary worker to vary the amounts of fiber, as its function is well known. Also, the reference does disclose the use of inulin and it is seen as listed first in the composition (col. 5, lines 54-70). No patentable distinction is seen in calling it a first fiber. Therefore, it would have been obvious to use inulin as disclosed by the reference.

ARGUMENTS

Applicant's arguments filed 3-1-04 have been fully considered but they are not persuasive. Applicants argue as to the double patenting rejection that the instant invention is directed toward a fiber solution of low viscosity and high fiber content and that Forusz '446 is directed toward a calcium solution. However, calcium is used in very small amounts and the claims do not exclude the use of calcium.

Applicants argue as to the 102 (e) rejection that Forusz '446 fails to disclose a "dietary acceptable amount of inulin" or at least 10% of the daily amount of dietary fiber.

However, the reference discloses as much as used in applicant's specification as above which therefore must be a dietary acceptable amount of inulin and 10% of the composition is disclosed in col. 5, lines 50-66 and col. 6, lines 10-15 if one adds the amounts of fiber together.

Applicants argue that Stillman still fails to disclose the importance of the balance of fibers as in claim 1. However, no amounts are found to create a balance of fibers. Nothing has been shown that Stillman does not show this viscosity. In addition, no criticality or unexpected results are seen in the use of any amounts of the claimed fibers. The reference discloses that the beverage is optically clear and makes such a beverage using a number of fibers. Therefore, it is seen that it would have been within the skill of the ordinary worker to adjust the amounts of fiber to make a clear beverage, which requires more skill than making a translucent beverage.

Applicants argue that there is no pH limitation in Stillman and that it appears to be in water-soluble dry form. Stillman is to Fiber Water, so it is not in a dry form. In addition, it is supposed to be similar to potable water (col. 4, lines 55-60), which generally has a pH of 6 to 7.

Applicants argue as to Topping that the inulin and or maltodextrin are used for different functions than those of the instant claims. However, nothing has been shown that it does not have the claimed viscosity or a pH of less than 6. Certainly, the manipulation of pH is well known and nothing new is seen in this. Applicants mention "faecal bulk promotion". This of course is a primary function of fiber, to do just that.

Applicants argue as to Green that it does not show the whole invention. However, it was used for what was disclosed as in the last office action.

The further arguments as to claims 6 and 10 have been addressed above.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen F. Pratt whose telephone number is 703-308-1978. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Milton Cano, can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HP 4-8-04


HELEN PRATT
PRIMARY EXAMINER